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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/873,978	06/12/1997	JON F. KAYYEM	A-63761-1/RF	2465

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ALBRITTON & HERBERT
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SAN FRANCISCO, CA 941114187

EXAMINER

MARSCHER, ARDIN H

ART UNIT PAPER NUMBER

1631

DATE MAILED: 06/23/2003

#210

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/873,978

Applicant(s)
Kayyem et al.

Examiner
Ardin Marschel

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 19, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47, 48, 57, 62-67, 72, and 73 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☒ Claim(s) 72 and 73 is/are allowed.
- 6) ☒ Claim(s) 47, 48, 57, and 62-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) 6 sheets 6) ☐ Other:

Applicants' arguments, filed 3/19/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Upon reconsideration, the following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

PRIORITY CLAIM

If applicant desires priority under 35 U.S.C. § 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. It is noted that this appears as the first sentence of the specification following the title. The status of non-provisional application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

NEW MATTER

Claims 47 and 48 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Reconsideration of the written basis for claims 47 and 48 has revealed that these claims were not submitted in the original filing in their present form. Reconsideration of the disclosure as originally filed for ethyl-pyridine protected sulfur atom practice reveals that its disclosure is only directed to terminal usage as shown in Figure 4 wherein the so protected sulfur is then utilized for gold electrode attachment as described in the specification on page 7, lines 15-19. Similar terminal protected sulfur atom practice with a trimethylsilyl ethyl moiety is shown in Figure 21 and described on page 10, last 2 lines. The gold electrode attachment practice with a protected sulfur atom is also summarized on page 65, lines 1-15. In summary, the terminal protected sulfur atom with a conductive oligomer has only been originally disclosed as filed as a terminal group and not generically without limitation as to where it is in the conductive oligomer as is a reasonable interpretation of claims 47 and 48. This broadening of disposition of such protected sulfur atoms is therefore NEW MATTER.

VAGUENESS AND INDEFINITENESS

Claims 57 and 62-67 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Abbreviations such as CPG as in claim 57 are generally viewed as vague and indefinite unless accompanied by the full name, optionally in parentheses. Clarification via clearer claim wording is requested.

Claims 62 and 66 cite a metallocene ligand but without defining the cooperativity of said ligand with the conductive oligomer and/or phosphoramidite nucleoside. Clarification as to the disposition of the metallocene ligand in the claimed composition is requested via clearer claim wording. It is noted that claim 64 cites a covalent attachment but then does not define the relative conductive oligomer attachment to the nucleoside. Claims dependent from claims 62 or 66 are also vague and indefinite due to their dependence.

INFORMALITIES

The disclosure is objected to because of the following informalities:

The Figure designations and the approved Figures do not have correspondence. For example, in the BRIEF DESCRIPTION OF THE DRAWINGS starting in the specification on page 7, Figure 1 is described whereas, in contrast, there is no Figure 1 in the approved drawing set, but rather only Figures 1A and 1B. This

non-correspondence also exists for Figures 18A, 18B, 19A, 19B, 20A, and 20B.

Appropriate correction is required.

Claims 72 and 73 are allowed.

Pursuant to the IDS, filed 3/28/03; the following applications, with any U.S. Patents which have been directly issued from said applications, are hereby made of record as having been considered: 08/743,798; 08/899,510; 08/911,085; 09/557,577; 09/577,429; 10/081,936; 10/236,481; 08/188,036; 08/475,051; 08/660,534; 08/659,987; 08/709,265; 08/709,263; 08/873,598; 08/946,679; 09/100,507; 09/306,749; 09/306,737; 09/306,768; 09/454,498; 09/459,751; 09/459,191; 09/454,497; 09/458,187; 09/545,227; 09/602,618; 09/845,746; 09/866,067; 10/279,742; 08/312,388; 08/786,187; 09/296,111; 09/296,078; 09/915,187; 08/786,153; 08/804,883; and 08/843,623.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

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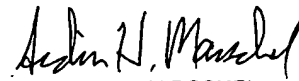
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

June 12, 2003


ARDIN H. MARSCHER
PRIMARY EXAMINER